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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Steven L. Rohall

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LOTUS AND RATIONAL SOFTWARE

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EXAMINER

WINTER, JOHN M

ART UNIT

PAPER NUMBER

3685

NOTIFICATION DATE

DELIVERY MODE

10/17/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

dave@davedagg.com

Office Action Summary	Application No. 09/995,151	Applicant(s) ROHALL ET AL.	
	Examiner JOHN M. WINTER	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-5, 9, 13-16 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-5, 9, 13-16 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. The Applicants amendment filed on July 10, 2008 is hereby acknowledged, Claims 3-5, 9, 13-16 and 19 are pending.

Response to Arguments

2. The Applicant states that the prior art references fail to disclose creating a shadow document from an original document, wherein the original document is an electronic mail message within a conversation thread of electronic mail messages, identifying, within the conversation thread of electronic mail messages, a parent document and a child document of the original document, wherein the original document is a reply to the parent document of the original document and wherein the child document of the original document is a reply to the original document, and storing references thereto in the shadow document, as in the present independent claim 3.

The Examiner responds that the features the Applicant considers lacking from the prior art record are directed towards non functional descriptive material. In the pending claim, the examiner submits that particular language does not serve as a limitation on the claim. In other **words language that is not functionally interrelated with useful acts, structure, or properties of the claimed invention will not serve as a limitation**. See in re Gulak, 217 USPQ 401 (CAFC 1983), *ex parte Carver*, 227 USPQ 465 (BdPatApp& Int 1985) and *in re Lowry*, 32 USPQ2d 1031 (CAFC 1994).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3-5, 9, 13-16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gay, (US Patent 6,792,145) in view of Rackman (US Patent No 5,903,646), and further in view of Newman et al (US Patent Application Publication 2004/0205535)

4. As per claim 3,

Gay ('145) discloses in a computer system operatively coupled to a network and capable of executing a communication process for sending and receiving electronic mail documents, a method comprising:

storing the shadow document in a computer usable memory.(Figure 2)

parsing the original document for selected logistical data comprising any of sender,

receiver, original size, subject, date or carbon copies of the original document (Column 7, line 29 – Column 8, line 10)

Gay ('145) does not explicitly disclose creating a shadow document from an original document wherein the original document is an electronic mail message within a

conversation thread of electronic mail messages; identifying one of a parent and child

document of the original document and storing a reference thereto in the shadow document

wherein the original document is a reply to the parent document of the original document and wherein the child document of the original document is a reply to the original document, and storing the logistical data in the shadow document;. Rackman ('646) discloses creating a shadow document from an original document wherein the original document is an electronic mail message within a conversation thread of electronic mail messages,; and storing the logistical data in the shadow document; (Column 8, lines 15-17; figure 4A) identifying one of a parent and child document of the original document and storing a reference thereto in the shadow document, wherein the original document is a reply to the parent document of the original document and wherein the child document of the original document is a reply to the original document, (Column 8, lines 47-52 -- Examiner notes language that is not functionally interrelated with useful acts, structure, or properties of the claimed invention will not serve as a limitation. See *in re Gulak*, 217 USPQ 401 (CAFC 1983), *ex parte Carver*, 227 USPQ 465 (BdPatApp& Int 1985) and *in re Lowry*, 32 USPQ2d 1031 (CAFC 1994)). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Gay ('145) method with the Rackman ('646) in order to create a redundant data archive so that the document could be retrieved in the event of primary system failing.

Gay ('145) does not explicitly disclose and determining and visually rendering a complete tree representing the conversation thread of electronic mail messages responsive at least in part to the shadow document subsequent to deletion of the original document. Newman et al ('535) discloses and determining and visually rendering a complete tree representing the conversation thread of electronic mail messages responsive at least in part to the shadow

document subsequent to deletion of the original document.,(Paragraph 34). It would be obvious to one having ordinary skill in the art at the time the invention was made to modify the Gay ('145) method in view of Newman et al ('535) in order to create a data view that allowed for identification of discrepancies between the documents. Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See e.g. MPEP §2106 II C: "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.] " As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.

Claims 9, 13 and 19 are in parallel with claim 3 and are rejected for at least the same reasons.

5. As per claim 4,

Gay ('145) discloses the method of claim 3 wherein "A" further comprises:
filtering the original document for selected content.(Figure 2)

6. As per claim 5,

Gay ('145) discloses the method of claim 3

Gay ('145) does not explicitly disclose wherein the shadow document further comprises selected data from the content of the original document. Rackman ('646) discloses wherein

the shadow document further comprises selected data from the content of the original document. (Figure 4A). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Gay ('145) method with the Rackman ('646) in order to create a redundant data archive using the original content so that the document could be retrieved in the event of primary system failing.

7. As per claim 14,

Gay ('145) discloses the method of claim 13 wherein at least one of the plurality of presented documents is an original document.(Figure 5)

8. As per claim 15,

Gay ('145) discloses the method of claim 13 wherein at least one of the plurality of presented documents is a shadow document.(Figure 5)

9. As per claim 16,

Gay ('145) discloses the method of claim 1 further comprising:
resolving the reference in a shadow document to one of the parent and child document, and
maintaining in memory data identifying a plurality of shadow documents and any parent and child documents thereof.(Figure 2)

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMW

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685